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| 24011 7590 07/02/2007 SILVERBROOK RESEARCH PTY LTD 393 DARLING STREET BALMAIN, 2041 AUSTRALIA | | | EXAMINER SUBRAMANIAN, NARAYANSWAMY | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/607,843

Applicant(s)

SILVERBROOK ET AL.

Examiner

Narayanswamy Subramanian

Art Unit

3692

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 April 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,8-20,23-29,31,36-43 and 46-48 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3,8-20,23-29,31,36-43 and 46-48 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date <u>4/26/07</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This office action is in response to applicants' communication filed on April 16, 2007. Amendments to claims 1, 23, 29 and 48 have been entered. Claims 1, 3, 8-20, 23-29, 31, 36-43 and 46-48 are currently pending and have been examined. The rejections and response to arguments are stated below. Applicants are respectfully requested to use the examiner's new art unit number (3692) in their future correspondences.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 1, 3, 8-20, 23-29, 31, 36-43 and 46-48 are rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory Subject matter.

35 USC 101 requires that in order to be patentable the invention must be a "new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof" (emphasis added).

Claims 1, 3, 8-20, 23-29, 31, 36-43 and 46-48 are drawn to "a method and apparatus for printing an interactive banking form on demand and performing online banking via a printed form". However it is not clear as to how the objective of performing online banking is achieved, because the last limitation in claims 1 and 29 recite "using said parameter to perform online banking". The limitation "to perform online banking" is interpreted as intended use of the step of using said parameter. Using the parameter is not the same as performing an online banking transaction. As such the claimed invention is directed to a judicial exception to 35 U.S.C. 101 (i.e., an abstract idea, natural phenomenon, or law of nature) and is not directed to a practical

application of such judicial exception because the claims do not require any physical transformation and the invention as claimed does not produce a useful, concrete, and tangible result.

The Court of Appeals for the Federal Circuit issued opinions in *State Street Bank & Trust Co. v. Signature Financial Group Inc.*, 149 F. 3d 1368, 47 USPQ2d 1596 (Fed. Cir. 1998) and *AT&T Corp. v. Excel Communications, Inc.*, 172 F.3d 1352, 50 USPQ2d 1447 (Fed. Cir. 1999). These decisions explained that, to be eligible for patent protection, the claimed invention as a whole must accomplish a practical application. That is, it must produce a “useful, concrete and tangible result.” *State Street*, 149 F.3d at 1373-74, 47 USPQ2d at 1601 02. To satisfy section 101 requirements, the claim must be for a practical application of the § 101 judicial exception, which can be identified in various ways: (a) The claimed invention “transforms” an article or physical object to a different state or thing. (b) The claimed invention otherwise produces a useful, concrete and tangible result, based on the factors discussed below.

The USPTO’s official interpretation of the utility requirement provides that the utility of an invention has to be (i) specific, (ii) substantial and (iii) credible. See MPEP § 2107. It is not clear as to what is the utility of using the parameter (relating to a banking transaction) because there is no assurance that this will result in the performance of the online banking transaction.

The tangible requirement does require that the claim must recite more than a § 101 judicial exception, in that the process claim must set forth a practical application of that § 101 judicial exception to produce a real-world result. Benson, 409 U.S. at 71-72, 175 USPQ at 676-77 (invention ineligible because had “no substantial practical application”). It is not clear as to what tangible result is produced by implementing the steps of the claim especially since there is

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no guarantee that implementing the steps of the claims will result in the performance of the online banking transaction.

For an invention to produce a “concrete” result, the process must have a result that can be substantially repeatable or the process must substantially produce the same result again. In re Swartz, 232 F.3d 862, 864, 56 USPQ2d 1703, 1704 (Fed. Cir. 2000) (where asserted result produced by the claimed invention is “irreproducible” claim should be rejected under section 101). The opposite of “concrete” is unrepeatable or unpredictable.

There is no useful, concrete and tangible result produced from implementing the steps of the claimed invention. The dependent claims are rejected for the same reason and by way of dependency on a rejected independent claim.

One suggestion for overcoming this rejection is by positively reciting the performance of the online banking transaction. For instance the last limitation can be recited as “performing online banking using said at least one parameter”.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

5. Claims 1 and 29 recite the limitation “method/apparatus for printing an interactive banking form on demand and performing online banking via a printed form” in the preamble of these claims. It is not clear how the objective of online banking is performed by implementing the steps of the claim. The last limitation “using said parameter to perform online banking” does not guarantee that the online banking transaction is actually performed. The limitation “to perform online banking” is interpreted as intended use of the step of using said parameter. Using

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the parameter is not the same as performing an online banking transaction. Hence the scope of the claims remains unclear. Claims 3, 8-20, 23-28, 31, 36-43 and 46-48 are rejected by way of dependence on a rejected independent claim. Appropriate clarification/correction is required. Appropriate clarification/correction is required.

One suggestion for overcoming this rejection is by positively reciting the performance of the online banking transaction. For instance the last limitation can be recited as “performing online banking using said at least one parameter”.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1, 3, 8-20, 23-29, 31, 36-43 and 46-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wanninger et al. (US Patent 4,937,439) in view of Official Notice, in view of Dymetman et al (US Patent 6,330,976 B1) and further in view of Richards et al (US Patent 6,539,361 B1).

Claim 1, Wanninger teaches a method for printing an interactive form on demand and performing a transaction via a printed form, the method including the steps of: determining a unique page identity for said form in a computer system (See Wanninger Column 4 lines 13-20); determining a page description for said form in the computer system, said page description comprising: (i) a description of said graphical information and (ii) a description of an interactive

element, which includes a zone of said interactive element on said form (See Wanninger Figure 2A, Column 6 line 60 – Column 7 line 10, Column 11 lines 15-45, Column 14 line 63 – Column 15 line 60, the content and response areas are interpreted to include a description of an interactive element); associating the page identity with the page description in the computer system (See Wanninger claim 2); sending page identity data and data regarding said graphical banking information together to a printer networked with the computer system; and printing the form using the printer, said printed form including graphical banking information and coded data, the coded data being indicative of an identity of the form and a plurality of locations on the form (See Wanninger Column 3 line 21 – Column 4 line 50).

Wanninger does not explicitly teach the steps of generating coded data in the printer using the page identity data; and printing the form on demand using the printer such that said graphical banking information and coded data are printed together, the transaction is an online banking transaction; receiving, in the computer system and from a sensing device operated by a banking customer, indicating data from the sensing device regarding the identity of the form and a position of the sensing device relative to the form, the sensing device, when placed in an operative position relative to the form, sensing at least some of the coded data and generating the indicating data using the at least some of the coded data; and identifying, in the computer system, using the indicating data and the page description associated with the page identity, at least one parameter relating to a banking transaction.

Official notice is taken that the steps of generating coded data in the printer using the page identity data; and printing the form on demand using the printer such that said graphical banking information and coded data are printed together are old and well known in the art. The

step of generating coded data in the printer is inherent in the printing of any coded data. The coded data has to be generated before it can be printed. Also an example of simultaneous printing of graphical information and coded data includes printing the bar-code along with other graphical information. Simultaneously printing the coded data and graphical information reduces the misalignment errors on the printed form.

It would have been obvious to one with ordinary skill in the art at the time of invention to include these steps to the invention of Wanninger. The combination of the disclosures taken as a whole suggests that users would have benefited from reduced errors on the printed form.

Wanninger does not explicitly teach the step wherein the transaction is an online banking transaction; receiving, in the computer system and from a sensing device operated by a banking customer, indicating data from the sensing device regarding the identity of the form and a position of the sensing device relative to the form, the sensing device, when placed in an operative position relative to the form, sensing at least some of the coded data and generating the indicating data using the at least some of the coded data; and identifying, in the computer system, using the indicating data and the page description associated with the page identity, at least one parameter relating to a banking transaction.

Dymetman teaches the steps of receiving, in a computer system and from a sensing device operated by a user, indicating data from a sensing device regarding the identity of the form (See Dymetman Column 3 line 45 – Column 4 line 24) and a position of the sensing device relative to the form (See Dymetman Column 3 lines 57-67), the sensing device, when placed in an operative position relative to the form, sensing at least some of the coded data and generating the indicating data using the at least some of the coded data (See Dymetman Column 3 lines 45-

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67); and identifying, in the computer system and from the indicating data and the page description associated with the page identity, at least one parameter relating to the transaction (See Dymetman Column 3 lines 45-67, the identified action is the one parameter relating to the transaction).

Both Dymetman and Wanninger are concerned with providing means for conducting transactions. It would have been obvious to one with ordinary skill in the art at the time of invention to include the disclosures of Dymetman to the invention of Wanninger. The combination of the disclosures taken as a whole suggests that users would have benefited from being able create and scan customized forms into a single unified process (See Wanninger Column 4 lines 34-38).

Wanninger does not explicitly teach the step where transaction is an online banking transaction and using the parameter to perform online banking.

Richards discloses the step wherein the financial transaction is an online banking transaction and using the parameter to perform online banking (See Richards Abstract, Column 1 lines 16-44, Column 2 line 67 - Column 3 line 54).

Both Wanninger and Richards are concerned with providing means for conducting transactions. It would have been obvious to one with ordinary skill in the art at the time of invention to include the disclosures of Richards to the invention of Wanninger. The combination of the disclosures taken as a whole suggests that online banking customers would have benefited from being able to use a form that makes banking easier.

Claim 29, Wanninger teaches an apparatus for printing an interactive form on demand and performing a transaction via a printed form, the apparatus comprising: a printer for printing

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the form, said printed form including graphical information and coded data, the coded data being indicative of an identity of the form and of a plurality of locations on the form (See Wanninger Column 3 line 21 – Column 4 line 50); and a computer system configured for: determining a unique page identity for said form in a computer system (See Wanninger Column 4 lines 13-20); determining a page description for said form in the computer system, said page description comprising: (i) a description of said graphical information and (ii) a description of an interactive element, which includes a zone of said interactive banking element on said form (See Wanninger Figure 2A, Column 6 line 60 – Column 7 line 10, Column 11 lines 15-45, Column 14 line 63 – Column 15 line 60, the content and response areas are interpreted to include a description of an interactive element); associating the page identity with the page description in the computer system (See Wanninger claim 2); sending page identity data and data regarding said graphical banking information together to the printer, said printer being networked with the computer system (See Wanninger Column 3 line 21 – Column 4 line 50).

Wanninger does not explicitly teach the features of a printer having a coded data generator for printing the form on demand, said printed form including graphical banking information and coded data printed together; receiving indicating data from a sensing device, the indicating data being indicative of the identity of the form and a position of the sensing device relative to the form, the sensing device when placed in an operative position relative to the form, sensing at least some of the coded data and generating sensing the indicating data using the at least some of the coded data, and identifying using the indicating data and the page description associated with the page identity, at least one parameter relating to a banking transaction.

Official notice is taken that the features of a printer having a coded data generator for printing the form on demand, said printed form including graphical information and coded data printed together are old and well known in the art. The step of generating coded data in the printer is inherent in the printing of any coded data. The coded data has to be generated before it can be printed. Also an example of simultaneous printing of graphical information and coded data includes printing the bar-code along with other graphical information. Simultaneously printing the coded data and graphical information reduces the misalignment errors on the printed form.

It would have been obvious to one with ordinary skill in the art at the time of invention to include these features to the invention of Wanninger. The combination of the disclosures taken as a whole suggests that users would have benefited from reduced errors on the printed form.

Dymetman teaches the features of receiving indicating data from a sensing device, indicating data from a sensing device regarding the identity of the form (See Dymetman Column 3 line 45 – Column 4 line 24) and a position of the sensing device relative to the form (See Dymetman Column 3 lines 57-67), the sensing device, when placed in an operative position relative to the form, sensing at least some of the coded data and generating the indicating data using the at least some of the coded data (See Dymetman Column 3 lines 45-67); and identifying, in the computer system and from the indicating data and the page description associated with the page identity, at least one parameter relating to the transaction (See Dymetman Column 3 lines 45-67, the identified action is the one parameter relating to the transaction).

Both Dymetman and Wanninger are concerned with providing means for conducting transactions. It would have been obvious to one with ordinary skill in the art at the time of invention to include the disclosures of Dymetman to the invention of Wanninger. The combination of the disclosures taken as a whole suggests that users would have benefited from being able create and scan customized forms into a single unified process (See Wanninger Column 4 lines 34-38).

Wanninger does not explicitly teach the step where transaction is an online banking transaction and using the parameter to perform online banking.

Richards discloses the step wherein the financial transaction is an online banking transaction and using the parameter to perform online banking (See Richards Abstract, Column 1 lines 16-44, Column 2 line 67 - Column 3 line 54).

Both Wanninger and Richards are concerned with providing means for conducting transactions. It would have been obvious to one with ordinary skill in the art at the time of invention to include the disclosures of Richards to the invention of Wanninger. The combination of the disclosures taken as a whole suggests that online banking customers would have benefited from being able to use a form that makes banking easier.

Claims 3 and 31, Dymetman discloses the steps of receiving, in the computer system, data regarding movement of the sensing device relative to the form, the sensing device sensing its movement relative to the form using at least some of the coded data; and identifying, in the computer system and from said movement being at least partially within said at least one zone, said at least one parameter of the transaction (See Dymetman Column 8 lines 27-33).

Claims 8 and 36, Dymetman discloses the step in which the parameter is an action parameter of the transaction, the method including effecting, in the computer system, an operation in respect of the action parameter (See Dymetman Column 4 lines 16-23).

Claims 9 and 37, Richards discloses the step where the action parameter includes a request for information relating to banking services, a request for a withdrawal of funds, a request for a transfer of funds, a request for an account balance, a payment of a bill (See Richards Column 1 lines 26-44).

Claim 10, Richards discloses the step in which the parameter is an option parameter of the transaction, the method including identifying, in the computer system, that the user has entered a hand-drawn mark by means of the sensing device and effecting, in the computer system, an operation associated with the option parameter (See Dymetman Column 30 line 65 – Column 31 line 39).

Claims 11 and 38, Richards discloses the steps in which the option parameter is associated with one of a request for information relating to banking services, an order for checks, a request to stop checks, an application for a new account, an application for a loan, a request for an account history, a request for a withdrawal of funds, a request for a transfer of funds, a request for an account balance, a payment of a bill, a request for a list of bill payments, an account, a currency, and a payee name (See Richards Column 1 lines 26-44).

Claims 12 and 13, Dymetman discloses the steps wherein the parameter is a text parameter of the banking transaction, the method including identifying, in the computer system, that the banking customer has entered handwritten text data by means of the sensing device and effecting, in the computer system, an operation associated with the text parameter including

converting, in the computer system, the handwritten text data to computer text (See Dymetman Column 30 line 65 – Column 31 line 39).

Claims 14 and 39, the step in which the text parameter is associated with at least one of a check amount, a payee name, a currency amount, a transfer amount, a payment amount, a payment date, and a check number is old and well known. These steps allow a checking transaction to be identified.

Claims 15 and 16, Dymetman discloses the steps in which the parameter is an authorization parameter of the transaction, the method including identifying, in the computer system, that the banking customer has entered a handwritten signature by means of the sensing device and effecting, in the computer system, an operation associated with the authorization parameter including verifying, in the computer system, that the signature is that of the customer (See Dymetman Column 30 line 65 – Column 31 line 39).

Claims 17 and 40, Richards discloses the step in which the authorization parameter is associated with authorization for at least one of access to account information, withdrawal of funds, transfer of funds, payment of a bill, modification of a bill payment, deletion of a bill payment, stopping of checks, and ordering of checks (See Richards Column 1 lines 26-44 and Column 3 lines 1-54).

Claims 18, 19 and 41, Dymetman does not teach the steps wherein the parameter is a picture parameter of the banking transaction, the method including identifying, in the computer system, that the banking customer has entered a hand-drawn picture by means of the sensing device and effecting, in the computer system, an operation associated with the picture parameter including picture parameter associated with a graphic design for a customer's checks.

Official notice is taken that having a picture parameter of the banking transaction, an operation associated with the picture parameter, which in turn is associated with a design for customer's checks is old and well known in the art. These steps help in timely identification of the parameter and also minimize the text necessary to identify the item (A picture is sometimes worth a thousand words).

It would have been obvious to one with ordinary skill in the art at the time of invention to include these steps to the disclosure of Wanninger. The combination of the disclosures taken as a whole suggests that users would have benefited from the ease in identifying the parameter of interest.

Claim 20, Richards discloses a method of claim 1, in which the form contains information relating to at least one of information relating to banking services, a request for an account history a request for a withdrawal of funds, a request for a transfer of funds, a request for an account balance, and a payment of a bill (See Richards Column 1 lines 25-45).

Claims 24, 26, 47 and 43, Dymetman discloses the steps of retaining a retrievable record of each form generated, the form being retrievable using its identity as contained in its coded data (See Dymetman Column 8 lines 6-13 and Column 22 lines 49-61); the sensing device contains an identification means which imparts a unique identity to the sensing device and identifies it as being associated with a particular user and in which the method includes monitoring, in the computer system, said identity (See Dymetman Column 17 lines 39-51).

Claims 25 and 27, Dymetman discloses the steps of distributing a plurality of forms using a mixture of multicast and PointCast communications protocols (See Dymetman Column 19

lines 16-21) and providing all required information relating to the banking transaction in the form to eliminate the need for a separate display device (See Dymetman Column 16 lines 31-42).

Claims 42, Dymetman discloses the step in which the sensing device includes a marking nib (See Dymetman Figure 8 and Column 30 line 65 – Column 31 line 39)

Claims 23, 28, 46 and 48, Wanninger does not explicitly teach the steps of printing the coded data where the coded data to be substantially invisible in the visible spectrum and a form printed on multiple pages, the printer includes a binding means for binding the pages.

Official notice is taken that the steps of printing the coded data where the coded data to be substantially invisible in the visible spectrum and printing on multiple pages and binding the pages is old and well known in the art. Printing coded data that is substantially invisible in the visible spectrum helps prevent fraud. Printing on multiple pages and binding them helps keep the records together.

It would have been obvious to one with ordinary skill in the art at the time of invention to include these steps to the disclosure of Wanninger. The combination of the disclosures taken as a whole suggests that users would have benefited from the time savings over a manual process and from keeping the records together by printing on multiple pages and binding them. Printing coded data that is substantially invisible in the visible spectrum helps prevent fraud.

Response to Arguments


8. Applicant's arguments with respect to pending claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure are listed on attached PTO form 892.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Narayanswamy Subramanian whose telephone number is (571) 272-6751. The examiner can normally be reached Monday-Thursday from 8:30 AM to 7:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Kramer can be reached at (571) 272-6783. The fax number for Formal or Official faxes and Draft to the Patent Office is (571) 273-8300.

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Dr. N. Subramanian
Primary Examiner
Art Unit 3692

June 21, 2007